Remarks

Applicants respectfully request reconsideration of this application in view of the following remarks.

Status of the Claims

Claims 1-40 are pending in this application. No amendments to the claims have been made in this response and therefore, Claims 1-40 remain pending for examination on the merits.

Restriction Requirement

The examiner has required restriction to one of the groups set forth in the Office Actions as follows:

I. Claims 1-11 and 20-26, drawn to compound and composition ...

II. Claims 12-14, drawn to combination of compound of claim 1 with other therapeutic agents ...

III. Claims 15-19, drawn to process of making the compounds and the product by the process ...

IV. Claim 27, drawn to a kit ...

V. Claims 28-30, drawn to a process of preparing a composition for nebulizer ...

VI. Claims 31-37, drawn to a method of treating diseases associated with beta-2 adrenergic receptor activity ...

VII. Claims 38-40, drawn to a process of preparing an intermediate ...

Applicants traverse the restriction requirement and respectfully request reconsideration of the requirement as stated. Applicants submit the present restriction among Groups I-VI is improper for the following reasons.

According to MPEP §803 entitled "Restriction – When Proper", there are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-§806.05(i)); and (B) there must be a serious burden on the examiner if restriction is required.

Restriction between Groups I and II: The examiner alleges that Groups I and II are related as combination and subcombination and applies the criterion of MPEP §806.05(c) in analyzing whether the groups are distinct. According to MPEP §806.05(c), the inventions are distinct if it can be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability, and (B) the subcombination can be shown to have utility either by itself or in other and different relations.

In performing this analysis, Group I is properly identified as the subcombination or element, e.g. the compound recited in Claim 1, and Group II as the combination, e.g. the combination of the compound of Claim 1 with other therapeutic agents, as recited, for example, in Claim 12. The examiner has failed to provide a showing that the combination as claimed, for example in Claim 12, does not require the particulars of the subcombination, e.g. the compound of Claim 1, for patentability. The examiner's stated reason "because the compound itself can be used to treat various diseases associated with beta-2 adrenergic conditions" does not address the question of the patentability of the combination. The Office Action further states "the subcombination has separate utility such as using as anti-inflammatory or anticholinergic agent." This statement would appear to be addressing the utility of the "other therapeutic agents" recited in Claim 12, whereas the second criterion of MPEP §806.05(c) requires the analysis of the utility of the subcombination, which in this instance is the compound of Claim 1. Accordingly, Applicants respectfully submit, the examiner has failed to demonstrate that Groups I and II are distinct.

As stated above, in addition to showing that the inventions are independent or distinct, as claimed, there must be a serious burden on the examiner, if restriction is to be required. MPEP §803 also states:

> If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions (emphasis added).

In the present instance, Groups I and II can be searched and examined together without posing an undue burden on the examiner. A proper search for the compound of Claim 1 will reveal references in which the compound is present together with another therapeutic agent. Claims 12-14 are dependent on Claim 1 and therefore include all the

limitations of Claim 1 and, in addition, impose further limitations. A finding of patentability of Claim 1 would automatically imply that Claims 12-14, which include all the limitations of Claim 1, were also patentable, for at least the reasons Claim 1 is patentable. Accordingly, since the examiner has not provided an adequate showing that Groups I and II are distinct, nor a showing that the examination of Groups I and II together would pose an undue burden, the restriction between Groups I and II is improper and may be withdrawn.

Restriction between Groups I and III: With respect to the restriction between Groups I and III, Claims 15-19, drawn to process of making the compound and the product made by the process, the examiner has applied the criterion of MPEP §806.05(f) in analyzing whether the groups are distinct. According to MPEP §806.05(f), inventions related as process of making and product made are distinct if it can be shown that (A) the process as claimed can be used to make other and different products or (B) that the product as claimed can be made by another and materially different process. The examiner has addressed the second criterion with the statement "In the instant case the product as claimed can be materially prepared by crystallizing in other solvent for example propanol or ethanol etc." However, Applicants' Claim 15 recites, among other limitations, "dissolving *N*-{2-[4-((*R*)-2-hydroxy-2-phenylethylamino)phenyl]ethyl}-(*R*)-2-hydroxy-2-(3-formamido-4-hydroxyphenyl)ethylamine in a first polar solvent to form a first solution;" (emphasis added) without specifying a particular polar solvent. Use of the solvents propanol or ethanol, does not constitute a materially different process as alleged by the examiner. Accordingly, the Office Action has not provided a showing that Group I and process Claims 15 and 16 of Group III are distinct.

Furthermore, according to MPEP §806.05(f), "a product defined by the process by which it can be made is still a product claim". Thus product by process Claims 17 and 18 are properly classified as product claims, Group I. In any event, the restriction between Groups I and III may be rendered moot. In accordance with *In re Ochiai* (71F.3d 1565, 37 UPQ 1127 (Fed. Cir. 1995) and MPEP §821.04, if applicant elects claims directed to the product and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitation of the allowable product claims will be rejoined.

Restriction between Groups I and V: The restriction between Group V, Claims 28-30, and Group I was also analyzed with respect to MPEP §806.05(f). In this case the examiner has alleged that "the composition as claimed can be made by materially different process such as by dissolving the compound in water and adjusting the pH by acid or base as required". Applicants respectfully submit the process suggested by the examiner, absent a buffering agent, would not necessarily provide the pharmaceutical composition for use in a nebulizer recited in Applicants' Claim 28. Furthermore the solubility of the compound in water is not disclosed in the application nor addressed by the examiner. The Office Action has not provided an adequate showing that the composition can be made by a materially different process and accordingly has failed to demonstrate Groups V and I are distinct. As for Group III discussed above, the restriction between Groups V and I may, in any event, be rendered moot. Claim 28 includes all the limitations of Claims 1 and 20, both of which are included in Group I. On allowance of the product claims of Group I, the claims of Group V may be rejoined.

Restriction between Groups I and VI: The examiner addressed one criterion of MPEP §806.05(h), in particular (2) whether the product as claimed can be used in a materially different process of using that product, in analyzing whether Group VI, drawn to a method of treating diseases associated with beta-2 adrenergic receptor activity is distinct from Group I. "In the instant case, the product as claimed can be used in a materially different process of using such as disclosed on page 3 of the instant specification." (Office Action, page 3, paragraph 5) Applicants disagree that the specification discloses a materially different process of use. (See page 3, lines 14-19, which disclose "a method of treating a disease or condition associated with β_2 adrenergic activity ... .") Applicants respectfully submit the examiner would need to point out where the materially different process is disclosed on page 3 of the specification to substantiate a finding that Groups I and VI are distinct.

Furthermore, Applicants respectfully submit that a search for the product and method claims together would not impose an undue burden. In the present application, the method claims 31-37 include all of the limitations of the product claim. Any search for the specific product of Claim 1 will, of necessity, also reveal references in which the specific product is used for treatment of disease. The restriction of Groups I and V may,

however, also be rendered moot since, in accordance with the provisions of MPEP §821.04, on allowance of the product claims, the method of use claims may be rejoined.

Restriction between Groups I and IV: The examiner cited MPEP §806.05(d) Subcombinations Usable Together with respect to the restriction between Group I and Group IV, Claim 27. The cited paragraph states "Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other." In the present instance, only one of the subcombinations recited in Claim 27, specifically "(b) a container whose contents comprise the pharmaceutical composition of Claim 20" refers to an element which is claimed separately. The other element of Claim 27, "(a) a nebulizer device" is not claimed separately. Accordingly, §806.05(d) would not appear to be applicable in the present instance. Furthermore, Claim 27 includes all the limitations of Claim 20, which is included in Group I. A finding of patentability of Claim 20 would imply Claim 27 was patentable for at least the reasons that Claim 20 was found to be patentable. Applicants respectfully submit the present restriction between Groups I and IV is improper and request that it be withdrawn.

In view of the foregoing, Applicants submit that the requirement for restriction among Groups I-VI put forth in the Office Action is improper and respectfully request that the restriction requirement be reconsidered and the restriction between Groups I and II, Groups I and III, Groups I and IV, Groups I and V, and Groups I and VI be withdrawn. Applicants do not traverse the restriction between Groups I and VII.

Election

Although traversing the restriction requirement for the above reasons, to comply with 37 C.F.R. §1.143, Applicants hereby elect Group I, Claims 1-11 and 20-26.

Conclusion

Reconsideration of this application in view of the above remarks and early examination on the merits is respectfully requested. In the event the examiner does not modify the restriction requirement, Applicants respectfully request a telephone interview with the examiner. Should the examiner wish to schedule a discussion, the examiner is invited to telephone the undersigned agent for Applicants at (650) 808-3764 (direct).

Respectfully submitted,

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